



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,561	10/31/2003	Thomas Grafenauer	03100134US	8413

7055 7590 03/13/2007
GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

EDWARDS, NEWTON O

ART UNIT	PAPER NUMBER
----------	--------------

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/13/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

8

Office Action Summary	Application No. 10/697,561	Applicant(s) GRAFENAUER, THOMAS	
	Examiner N Edwards	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) 6-13, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 14-16 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/06</u> | 6) <input type="checkbox"/> Other: _____ |

Applicant argues that 1) the Examiner has omitted one of the two criteria for a proper restriction now established by the USPTO.

This is a serious allegation. Assuming, arguendo you talking about MPEP 806.5(f), the restriction of 12/19/ 06 clearly meet the criteria. MPEP 806.5(f) set forth criteria one or two, there is no criteria for both criteria one and criteria two for a proper restriction.

MPEP 803 is not mentioned in the restriction, however a serious burden is shown in the restriction by divergent subject matter between group I and group II, divergent classification, and the divergent search. The IDS submitted by applicant of 11/13/06 for group I and group II is at least about 500 references and well over 10,000 pages, which also show a serious burden to consider and search both groups at once. Applicant has failed to address the restriction on the merits as presented and the restriction is deemed proper for reasons of record. The restriction is hereby Made FINAL.

Regarding the IDS of 11/13/06 (second submission), the lined references were not considered because Applicant has failed to comply with 37 CFR 1.98 and provide a statement of relevance for each foreign reference not in english. For the record, this is applicant's second notice (see 10/30/06).

1. Claims 1-5 and 14—16,19-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for HDF support board, does not reasonably provide enablement for support board (not limited to any material). The specification does not enable any person skilled in the art to which it pertains, or with

Art Unit: 1774

which it is most nearly connected, to make or use the invention commensurate in scope with these claims. Claims 1 and 21 recite "a support board" is broader in scope than the enabling disclosure which is limited to HDF support board at page 1 line 2, for example.

Correction is required.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to for failing to provide support for the invention as is now claimed.

The specification as filed fails to support 1) Claim 21, Line 4 "at least one paper free layer...".

Claims 21-22 are rejected under 35 USC 112, first paragraph, for the reason(s) given in the objection above.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

4. Claims 1-5, 14-16, 19-22 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. US 7,171,998, Vogel discloses your claimed invention. Hence, it is unclear to the PTO in view of the reference, as to the inventorship of the claimed subject matter in the instant case.

Art Unit: 1774

5. Claims 1-5,14-16,19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, line 2 "a decoration of wood or tile" is vague and indefinite as to the intended meaning of the phrase and not a positive recitation of a wood fiber board in the body of the claim. Also, the preamble of claim 1 recites a wood fiber board but the body of the claim is not commensurate in scope since there is no wood fiber board present in the body of the claim. A print (line 3) of wood or tile decoration is not wood or a wood fiber board. See claim 21 for the same problems as claim 1. Correction is required.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 14-16,19-22 are rejected under 35 U.S.C. 102(a or e) as being clearly anticipated by Eiserman (US 6,568,148) alone or optionally taken with Vogel (US 7,171,998) or Maes (5,882,569).

Eiserman teaches floor covering element or surface covering comprising a upper face sheet 2(panel) having a support layer 7 or support plate (support board) made of HDF

Art Unit: 1774

fiberboard or MDF fiber board or cellulose in which abrasion resistant material 8 in the form of corundum particles is embedded there with. Eiserman further teaches the floor covering element or surface covering further include a decorative layer 4 printed (paper less) on the support layer 7 top and/or bottom. Eiserman still further teaches floor covering or surface covering includes at least one bonding layer 9 of melamine resin (transparent synthetic resin). The Primary Examiner has a reason to believe that Eiserman's flooring covering or surface layer inherently possess a relief of the decoration on the top and/or bottom of the support layer or support plate due to the same structural identity (same structure as claimed) and Eiserman teaches all the layer are press together. See col. 4 line 20-end, fig 2, fig 6, fig 7, col. 5 lines 1-5, claim 6, and claim 10.

Vogel and Maes are cited to show that pressing a decorative panel as taught by Eiserman inherent produce a relief of the decoration on the top and /or bottom of the of the support layer or support plate.

Art Unit: 1774

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

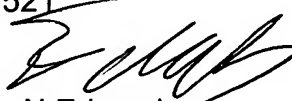
8. Claims 1, 2, 19, and 21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Chen '009 (US 6,617,009) or Chen '934 (US 6,986,934) or Chen '460 (US 7,169,460).

Chen '009, Chen '934, and Chen '460 (will be referred to as Chen) all teach a thermoplastic flooring plank (panel) comprising printing (paper less) a design or decoration of wood grain on the at least the top of core plank (support board) and a protective polymeric coating (transparent synthetic resin) on at least top of the design or decoration. See col. 3 lines 1-9, col. 11 lines 41-64, and col. 12 lines 1-8, for example.

No claims are allowed.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The enclosed patents disclose the state of the prior art.

Any inquiry concerning this communication should be directed to Primary Examiner Edwards at telephone number 571-272-1521


N Edwards
Primary Examiner
Art Unit 1774